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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,232	07/02/2001	Uday W. Joshi	F-281	1871

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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,232

Applicant(s)

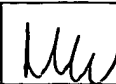
JOSHI ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the Response to Restriction paper received on 5/24/2004. Group I including claims 1-9 are elected for continued examination.

Drawings

2. The drawings (received on 7/02/2001) are acceptable for examining purposes.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that

promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

B. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1,7 (1981}. However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

C. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI}. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non

statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

D. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

E. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.*

at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

F. In the present application, the claimed steps can be done manually. In order to place the above claims within statutory subject matter, it is suggested that the Applicants amend the claims to more clearly define claimed steps are being performed

by technology, such as computer processors, electronic communication networks, etc.

G. For instance, these claimed steps do not require "technological art":

a) Per independent claim 1: - e.g., receiving a design for a mail piece..

b) Per dependent claim 9: : - e.g., receiving a design for a mail piece from a first business, and a different mail piece from a second business.

All dependent claims are objected for dependencies (of independent claim 1).

Claim Rejections - 35 USC § 112

4. Independent claim 1 has a gap/(is incomplete) because the claim does not say this step of "combination/merging" by using computer or manually; if doing it manually, several different designs can be pasted on a bigger paper and copying it to produce a piece with "single print run" having different finished orders; therefore, 35 USC 112, 2nd para. rejection is applied (content of applicant's specification is not used as evidence that the scope of the claims is consistent with the subject matter which applicant regards as his invention).

Claim Objections

5. Claims 2-9 are objected for incorporating a defect from parent claim 1 by dependencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a), which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negated by the manner in which the invention was made.

6. **Claims 1-2, 5, 8 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994).**

A. Per claim 1: **Mori et al.** suggest a method for generating a mailing comprising:

- receiving a request for printing (e.g., a design for a mail piece - see Mori et al., Fig.27, Fig.18, ref. 523" or Fig.25, ref. 559);
- converting said design to a viewable format (see Mori et al., 13:6-12, and 21:11-24); said viewable format being viewable from a remote computer via a network (see Mori et al., Fig.1);
- receiving an order for a plurality of pieces of said at least one mail piece from said remote computer via said network see Mori et al., Fig.1, Fig.27, Fig.18, ref. 523', or Fig.25, ref. 559);

- combining said order with another order for a different mail piece to produce a single print run, then printing each mail piece and a different mail piece on a paper (see Mori et al., 18:54-55 2 different info. inputs can be printed upon selecting a "both-side printing" button);

Mori et al. do not disclose about mailing finished mail piece.

However, it would have been obvious with one of ordinary skill in the art at the time of invention to recognize that Mori et al. distribute/sending printed jobs after finishing - mailing finished mail pieces (see Mori et al., Fig.44).

B. Per claim 8: Mori et al. obviously suggest about arranging a single print run in a presort sequence - Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients.

C. Per claim 2: Mori et al. also teach that network is the Internet (see Mori et al., Fig.1, and Fig.11).

D. Per claim 5: Mori et al. receive customized info. to print on a mail piece, e.g., a font type (see Mori et al., 21:34-52).

7. **Claims 3-4, 6-7, 9 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994), in view of Fabel (US Pat. 6,209,779).**

A. Per claims 3-4: Mori et al. obviously receive contact information (see Mori et al., Fig.27 "INFORMATION NOTICE"),

wherein said contact information is printed on a mail piece (see Fabel, Fig.15).

Fabel also receives an order further comprises information (receiving respective contact information) which is a recipient mailing list including names, wherein each name is printed on a mail piece (see Fabel, Fig.15).

E. Per claim 6: Mori et al. do not disclose a printed job on a postcard. However, Fabel teaches about printing on a post card having a first and second side (see Fabel, the abstract).

B. Per claim 7: Mori et al. suggest a step of printing on first side and second side of a sheet (see Mori et al., Fig.27 wherein the selected type of data is "BOTH-SIDE PRINTING").

Mori et al. do not teach that print job is a postcard printing job.

However, Fabel teach that limitation (see Fabel, the abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine both Mori et al., and Fabel for printing on a postcard with 2 sides instead of a plain sheet because a postcard is made by a sheet of paper. Mori et al.'s printer can be adjusted paper thickness to accept a thicker paper than regular papers.

C. Per claim 9: Mori et al. and Fabel do not explicitly disclose about receiving a design further comprises receiving a design

from a first business, and receiving another designed by a different party.

However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine both Mori et al., and Fabel for printing a mail piece from 2 different parties because different input information can be input one page after another to be printed on 2 different sides of a postcard by the feature of Mori et al. "BOTH-SIDE PRINTING".

Conclusion

8. Claims 1-9 are not patentable.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687/703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Serial Number: 09/898,232

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CuN
CUONG H. NGUYEN
Primary Examiner
Art Unit 3625